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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,994	05/05/2005	D. Stephen Lane	00839-03	2589
34444 7590 12/19/2007 UNIVERSITY OF VIRGINIA PATENT FOUNDATION 250 WEST MAIN STREET, SUITE 300 CHARLOTTESVILLE, VA 22902				
			EXAMINER MRUK, BRIAN P	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 12/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/533,994

Applicant(s)

LANE ET AL.

Examiner

Brian P. Mruk

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to Applicant's amendment filed October 4, 2007. Applicant has amended claims 1, 15, 22, 31, 40, 47 and 54. Currently, claims 1-59 remain pending in the application.
2. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office actions, Paper Nos. 20060211, 20060826, 20070212.
3. The rejection of claims 1-59 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bennet, WO 01/40547, is maintained for the reasons of record.
4. The rejection of claims 1-59 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bennett, U.S. Patent No. 6,033,553, is maintained for the reasons of record.
5. The rejection of claims 1-59 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bennett, U.S. Patent No. 6,217,742, is maintained for the reasons of record.

6. The rejection of claims 1-59 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stokes et al, U.S. Patent No. 6,022,408, is maintained for the reasons of record.

7. The rejection of claims 1-59 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Foltz et al, U.S. Patent No. 5,985,011, is maintained for the reasons of record.

Response to Arguments

8. Applicant's arguments filed October 4, 2007 have been fully considered but they are not persuasive.

Applicant continues to argue that each of Bennet, WO 01/40547, Bennett, U.S. Patent No. 6,033,553, Bennett, U.S. Patent No. 6,217,742, Stokes et al, U.S. Patent No. 6,022,408, and Foltz et al, U.S. Patent No. 5,985,011, do not teach or suggest in general the corrosion protection of inhibition for metals in cementitious materials by lithium nitrate or other salts. However, the examiner respectfully disagrees. Specifically, the examiner maintains that each of the above listed references clearly teach the addition of lithium nitrate to cement, as required in the instant claims. It is noted by the examiner that the only required process step required in the instant claims is adding lithium nitrate to a cementitious material, which is clearly taught by each of the prior art references. Furthermore, with respect to the corrosion protection of inhibition for metals in cementitious materials by lithium nitrate or other salts limitation, the

examiner respectfully maintains that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the examiner asserts that each of the above listed references would be capable of performing the intended use, since each of the above listed references clearly teach the addition of lithium nitrate to cementitious material. Therefore, the examiner maintains that the limitations of the instant claims are met by the above listed references.

The declaration under 37 CFR 1.132 filed October 4, 2007 is insufficient to overcome the rejection of claims 1-59 based upon Bennet, WO 01/40547, Bennett, U.S. Patent No. 6,033,553, Bennett, U.S. Patent No. 6,217,742, Stokes et al, U.S. Patent No. 6,022,408, and Foltz et al, U.S. Patent No. 5,985,011 as set forth in the last Office action because: a 1.132 Declaration cannot overcome a 35 U.S.C. 102 rejection. See *MPEP 716*. Furthermore, the examiner asserts that applicant's opinion does not overcome the 103 rejections, since an opinion that the prior art is not capable of meeting the method of inhibiting corrosion of metals embedded in a cementitious material is not a proper showing. See *MPEP 716.01(c)*. Specifically, the examiner asserts that applicant's 1.132 Declaration does not show proof and/or factual evidence that the prior art references are not capable of performing the intended use, i.e: the corrosion protection of inhibition for metals in cementitious materials by lithium nitrate or other salts. Therefore, the examiner respectfully maintains that instant claims 1-59 are

anticipated by each of Bennet, WO 01/40547, Bennett, U.S. Patent No. 6,033,553, Bennett, U.S. Patent No. 6,217,742, Stokes et al, U.S. Patent No. 6,022,408, and Foltz et al, U.S. Patent No. 5,985,011 as set forth in the last Office action.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Mon-Thurs (7:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPM
Brian P Mruk
December 16, 2007

Brian P. Mruk
Brian P Mruk
Primary Examiner
Art Unit 1796